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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/722,760	11/27/2000	Eduard Michel	1999DE132	4985

25255 7590 06/14/2004

CLARIANT CORPORATION
INTELLECTUAL PROPERTY DEPARTMENT
4000 MONROE ROAD
CHARLOTTE, NC 28205

EXAMINER

NOTE, JANIS L

ART UNIT	PAPER NUMBER
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1756

DATE MAILED: 06/14/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/722,760

Applicant(s)

MICHEL ET AL.

Examiner

Janis L. Dote

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 08 April 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attached, paragraph 1.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached paragraph 2.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1,4-10 and 14-22.

Claim(s) withdrawn from consideration: 11-13.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Janis L. Dote
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PRIMARY EXAMINER
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1. The proposed amendment to claim 4, filed after the final rejection on Apr. 8, 2004 (Amdt040804), deleting "substituted ammonium" from the members listed in the Markush group, raises new issues. Applicants' elected species encompasses the substituted ammonium low molecular weight cation recited in claim 4. Because the "substituted ammonium" low molecular weight cation was found to be unpatentable over the prior art for the reasons discussed in the final rejection mailed on Jan. 12, 2004, the examiner did not have to further consider the other members of the Markush group. See MPEP 803.02.

The proposed amendment to claim 1, adding the limitations "step of adding as a charge control agent a structured silicate salt . . . " (emphasis added) and "cation is a low molecular weight organic cation or a combination of a low molecular weight organic cation with NH_4^+ . . . or with a transition metal" (emphasis added), raises new issues because said limitations were not previously present in the claims at the time the final rejection was mailed.

The proposed amendment to claim 22, adding the limitation "adding a charge control agent . . . wherein the charge control agent is distearyldimethyl ammonium bentonite (emphasis added)," raises new issues because the limitation was not previously

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present in the claims at the time the final rejection was mailed.

The addition of proposed new claim 23 raises new issues because the limitations "step of adding as a charge control agent a structured silicate salt . . . " (emphasis added) and "cation is a low molecular weight organic cation or a combination of a low molecular weight organic cation with NH_4^+ . . . or with a transition metal" (emphasis added), and "the charge control agent imparts either a positive or negative charge" were not previously present in the claims at the time the final rejection was mailed.

Moreover, the "Amendment to claims" filed in Amdt040804 is not in compliance with 37 CFR 1.121. The amendment to claim 5 at line 29, tries to delete "[,]" which was deleted previously in the amendment to claim 5 filed on Sep. 30, 2003.

37 CFR 1.121(b)(1)(ii) states that "[t]he full text of any replacement paragraph with markings to show all the changes relative to the previous version of the paragraph. The text of any added subject matter must be shown by underlining the added text. The text of any deleted matter must be shown by strike-through except that double brackets placed before and after the deleted characters may be used to show deletion of five or fewer consecutive characters" (emphasis added).

2. The examiner's refusal to enter the amendment filed after the final rejection on Apr. 8, 2004 (Amdt040804), renders moot

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applicants' arguments regarding said amendment. The rejections of claims 1, 4-10, and 14-22 under 35 USC 103(a) over Japanese Patent 8-6295 (JP'295) combined with the other cited references stand for the reasons discussed in the final rejection mailed on Jan. 12, 2004 (CTFR011204).

Furthermore, applicants' arguments are not persuasive regarding the rejections of claims 1, 4, 7-10, 14-18, and 21 under 35 USC 103(a) over Canadian Patent 2,244,367 (CA'367), and of claims 1, 4, 7-10, and 18 under the judicially created doctrine of obviousness-type double patenting over claim 1-8 of US 6,030,738 (US'738), set forth in the final rejection mailed on Jan. 12, 2004 (CTFR011204), paragraphs 13 and 15, respectively. The term "low molecular weight cation" recited in the instant claims does not exclude the polymeric ammonium salt, n,m-ionens, and polyviologens disclosed by CA'367 or recited in the claims of US'738. The instant claims do not recite that the low molecular weight cation is "not polymerized." Nor does the originally filed specification support applicants' allegation that the "low molecular weight organic cation . . . is not polymerized." The originally filed specification does not define the term "low molecular weight cation" as not being polymerized. Nor does the originally filed specification limit the term "low molecular weight cation" as not being polymerized.

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Rather, the originally filed specification at page 9, lines 18-21, states that "[t]he low molecular weight organic cations are preferably substituted ammonium, phosphonium, thionium or triphenylcarbonium ions or a cationic metal complex. Preferred ions are low molecular weight, that is to say nonpolymeric, ammonium ions of the formulae (a)-(j)" (emphasis added). Accordingly, the rejections over CA'367 and US'738 stand.